



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,207	08/10/2004	Amit Mate	NOKIA.4010US	8979
43829	7590	05/07/2007		
ROBERT M BAUER, ESQ. LACKENBACH SIEGEL, LLP 1 CHASE ROAD SCARSDALE, NY 10583			EXAMINER TORRES, JOSEPH D	
			ART UNIT 2112	PAPER NUMBER
			MAIL DATE 05/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/030,207	Applicant(s) MATE ET AL.	
	Examiner Joseph D. Torres	Art Unit 2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. In view of the amendment filed 04/05/2007, the Examiner withdraws all prior rejections under 35 USC § 112.

Claim Objections

2. In view of the amendment filed 04/05/2007, the Examiner withdraws all prior objections to the claims.

Oath/Declaration

3. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Khan reference. The Examiner asserts that Swearing back of Reference is a legal process requiring an Affidavit or Declaration under 37 CFR 1.131 (see MPEP § 715). Arguments alone are not sufficient for such a process. Furthermore, the document is insufficient to show reduction to practice: "proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose" (see MPEP § 715.07).

Response to Arguments

4. Applicant's arguments filed 04/05/2007 have been fully considered but they are not persuasive.

The Applicant contends, "Applicants therefore submit simultaneously herewith documents showing a draft of the UK priority application dated June 29, 1999, thereby establishing that the invention was reduced to practice prior to the July 2, 1999 filing date of the Khan et al. patent".

The Examiner asserts that Swearing back of Reference is a legal process requiring an Affidavit or Declaration under 37 CFR 1.131 (see MPEP § 715). Arguments alone are not sufficient for such a process. Furthermore; the document is insufficient to show reduction to practice: "proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose" (see MPEP § 715.07).

The Examiner disagrees with the applicant and maintains all rejections of claims 23-42. All amendments and arguments by the applicant have been considered. It is the Examiner's conclusion that claims 23-42 are not patentably distinct or non-obvious over the prior art of record in view of the references, Khan; Farooq et al. (US 6367045 B1, hereafter referred to as Khan) in view of Johansson; Mathias et al. (US 6643813 B1, hereafter referred to as Johansson) in view of Ejzak; Richard P. et al. (US 5444718 A, hereafter referred to as Ejzak) in view of Wiedeman; Robert A. et al. (US 5448623 A,

Art Unit: 2112

hereafter referred to as Wiedeman) as applied in the last office action, filed 12/05/2006.

Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 47 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer program product can be a computer program or signal carrying the computer program. Neither signals nor computer programs fall into any of the statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 23-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Khan; Farooq et al. (US 6367045 B1, hereafter referred to as Khan).

Art Unit: 2112

See the Non-Final Action filed 12/05/2006 for detailed action of prior rejections.

7. Claims 43-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Ejzak; Richard P. et al. (US 5444718 A, hereafter referred to as Ejzak)

35 U.S.C. 102(b) rejection of claim 43-47.

Col. 4, lines 7-36 in Ejzak teach periodically sending from the receiver to the transmitter a ordered bitmap specifying a 1 in an ordered packet position for a correctly received packet and a 0 for an incorrectly received packet. A contiguous group of ones (1s) between zeros (0s) in the bitmap is a binary representation of a number which is indicative of the spacing between incorrectly received packets.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khan; Farooq et al. (US 6367045 B1, hereafter referred to as Khan).
See the Non-Final Action filed 12/05/2006 for detailed action of prior rejections.
9. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan; Farooq et al. (US 6367045 B1, hereafter referred to as Khan) in view of Johansson; Mathias et al. (US 6643813 B1, hereafter referred to as Johansson).
See the Non-Final Action filed 12/05/2006 for detailed action of prior rejections.
10. Claims 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan; Farooq et al. (US 6367045 B1, hereafter referred to as Khan) in view of Ejzak; Richard P. et al. (US 5444718 A, hereafter referred to as Ejzak).
See the Non-Final Action filed 12/05/2006 for detailed action of prior rejections.
11. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan; Farooq et al. (US 6367045 B1, hereafter referred to as Khan) in view of Wiedeman; Robert A. et al. (US 5448623 A, hereafter referred to as Wiedeman).
See the Non-Final Action filed 12/05/2006 for detailed action of prior rejections.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

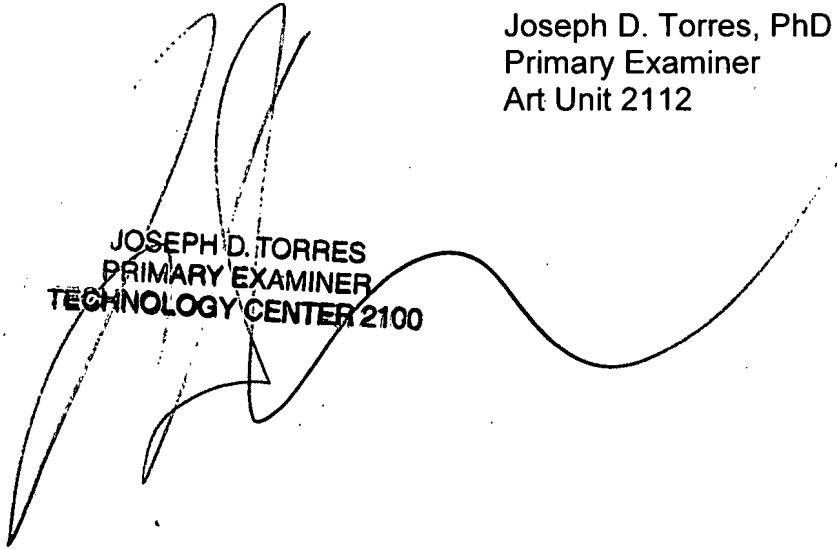
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (571) 272-3829. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2112

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joseph D. Torres, PhD
Primary Examiner
Art Unit 2112



JOSEPH D. TORRES
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100